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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,034	11/18/2003	Masayoshi Nanami	FY.F5642US2C	7337
20995	7590	03/07/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			VASUDEVA, AJAY	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3617	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,034	Applicant(s) NANAMI ET AL.	
	Examiner Ajay Vasudeva	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25, 26 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 26, 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

New Rejection

1. In view of the below noted discrepancies in the instant application with respect to the prior-filed application, the allowability of claims 25, 26 and 30-32 -- allowed in the previous Office action -- has been withdrawn.

Therefore, this Office action is made non-final. The examiner regrets the inconvenience caused to the applicants and their representative.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/596,786, filed 6/19/2000, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

In claim 25, applicant claims “**sensor configured to detect a tilting motion of the hull and to emit a signal corresponding to the tilting motion...closing one or more valves...within a lubrication system...if the sensor has generated a signal for at least the predetermined time**”.

Although the Specification, as originally filed, describes a closing of lubrication valves when the watercraft has overturned, it does not specifically disclose the closing of the valves in response to a sensor generating a signal for a predetermined time, as being claimed.

Similarly, in claim 30, applicant claims “**a capsize sensor configured to detect a tilting motion of the hull and to emit a signal corresponding to the tilting motion...a fuel injector having a solenoid-driven valve...the controller being configured to terminate electrical power to the solenoid if the capsize sensor has emitted the signal for at least the predetermined time**”.

The Specification, as originally filed, merely describes “fuel injectors 248 are opened and closed by solenoid valves, which are, in turn, controlled by the ECU 154”. The original Specification, however, does not describe a closing of the solenoid valves as a result of either a tilting or an overturning of the watercraft, and further, does not describe the interruption of electrical power for a closing of the solenoid valves as a result of such tilting or overturning.

3. However, this application repeats a substantial portion of prior-filed Application No. 09/596,786, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a **continuation-in-part** of the prior application. Should applicant desire to obtain the

Art Unit: 3617

benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Applicant is reminded that if the applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the accurate relationship (i.e., continuation-in-part) of the applications.

Oath/Declaration

4. If amending the relationship with the prior application, applicant is required to submit a substitute declaration or oath pursuant to 37 CFR 1.63 (d)(1).

Specification

5. The Specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- A sensor configured to detect a tilting motion of the hull and to emit a signal corresponding to the tilting motion, as set forth in claim 25.
- Closing one or more valves within the lubrication system if the sensor has generated a signal for at least the predetermined time, as set forth in claim 25.
- A capsize sensor, as set forth in claim 30.
- The capsize sensor detecting a tilting motion of the hull and emitting a signal corresponding to the tilting motion, as set forth in claim 30.

- A controller terminating electrical power to the solenoid, as set forth in claim 30.
- The controller terminating electrical power to the solenoid if the capsize sensor has emitted the signal for at least the predetermined time, as set forth in claim 30.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 25, 26 and 30-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the ***originally filed*** specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 25, applicant claims “sensor configured to detect a tilting motion of the hull and to emit a signal corresponding to the tilting motion...closing one or more valves...within a lubrication system...if the sensor has generated a signal for at least the predetermined time”.

Although the Specification, as originally filed, describes a closing of lubrication valves when the watercraft has overturned, it does not specifically disclose the closing of the valves in response to a sensor generating a signal for a predetermined time, as being claimed.

Similarly, in claim 30, applicant claims "a capsize sensor configured to detect a tilting motion of the hull and to emit a signal corresponding to the tilting motion...a fuel injector having a solenoid-driven valve...the controller being configured to terminate electrical power to the solenoid if the capsize sensor has emitted the signal for at least the predetermined time".

However, the Specification, as originally filed, merely describes "fuel injectors 248 are opened and closed by solenoid valves, which are, in turn, controlled by the ECU 154". The original Specification does not describe a closing of the solenoid valves as a result of either a tilting or an overturning of the watercraft, and further, does not describe the interruption of electrical power for a closing of the solenoid valves as a result of such tilting or overturning.

Because the original Specification does not support the above described limitations of the claim, it would not have enabled one to make and/or use the invention as being claimed.

Conclusion

8. In the event the status of application is changed to a **continuation-in-part** of the prior application, applicants are requested to give due consideration to double patenting issues with respect to the prior application.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

Art Unit: 3617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Examiner
Art Unit 3617


AJAY VASUDEVA 12/26/06
PATENT EXAMINER